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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEMAL GULER,
REN WU, and
FRANCOIS RENE PAUL BOULANGER

Appeal 2009-005883
Application 10/683,985
Technology Center 3600

Decided: March 10, 2010

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Kemal Guler, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 11-14, 16-21, and 23-36. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Claims 1-10, 15, and 22 have been canceled.

SUMMARY OF DECISION

We AFFIRM-IN-PART and enter a new ground of rejection pursuant to 37 C.F.R. 41.50(b).¹

THE INVENTION

This invention is a system and method for controlling feedback in an auction by customizing feedback rules not earlier than entry of auction rules into an auction program by an end-user. Specification [0003].

Claim 17, reproduced below, is illustrative of the subject matter on appeal.

17. A computer system, comprising:
a processor operable to execute instructions of an auction program;
a network interface coupled to said processor;
wherein the auction program is operable to provide data to client computers over the network interface for generation of an auction interface, wherein the auction interface permits an end-user of an online

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jan. 19, 2008) and Reply Brief ("Reply Br.," filed Jun. 30, 2008), and the Examiner's Answer ("Answer," mailed May 1, 2008).

auction to customize feedback of the online auction by selecting a feedback rule, and wherein the feedback rule is from the group consisting of feedback timing, personalized feedback, and feedback based on rank.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Abeshouse	US 2002/0099643 A1	Jul. 25, 2002
Chambers	US 2005/0055299 A1	Mar. 10, 2005

The following rejections are before us for review:

1. Claims 11, 14, 16, and 23-36 are rejected under 35 U.S.C. §102(b) as being anticipated by Abeshouse.
2. Claims 12-13 and 17-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Abeshouse and Chambers.

ISSUES

The first issue is whether claims 11, 14, 16, and 23-36 are anticipated under 35 U.S.C. § 102(b) by Abeshouse. Specifically, the first major issue is whether Abeshouse describes a method that when executed allows selection of a feedback rule for an online auction contemporaneously with an end-user initiating the online auction. The second major issue is whether Abeshouse describes a means for executing program and instructions operable to execute instruction of an auction program, where the auction program provides an auction interface, which permits an end-user to select feedback from a pre-defined list of feedback rules.

The second issue is whether claims 12-13 and 17-21 are unpatentable over Abeshouse and Chambers. The major issue is whether one of ordinary skill in the art would have been led by Abeshouse and Chambers to a computer system having a processor that is operable to execute an auction program that provides an interface that permits an end-user of an online auction to customize feedback of the online auction by selecting a feedback rule.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim Construction

1. The Specification does not contain an express definition of “selection.”
2. A definition of “selection” is “[t]he act of selecting or the fact of being selected.” *See Webster’s II New Riverside University Dictionary* 1057 (1984).
3. A definition of “select” is “[t]o pick out from among several: CHOOSE.” *See Webster’s II New Riverside University Dictionary* 1057 (1984).

The scope and content of the prior art

Abeshouse

4. Abeshouse describes a system having a computer processor that runs a reverse auction, where suppliers supply bids to a purchaser of goods or services. Abeshouse [0055].
5. Abeshouse describes using user interfaces. Abeshouse [0089]
6. Abeshouse describes using an auction coordinator, obtaining data from a purchaser, to administer the auction setup and preparation, including sending a Request for Quotation to the suppliers. Abeshouse [0017], [0018], and [0022].
7. Abeshouse describes using differential market feedback technology that includes a variety of differential market feedback rules that “are used to define when a bidder can view market feedback.” Abeshouse [0089]. *See also* Abeshouse [0081]-[0082].
8. Abeshouse states:

By combining feedback rules and feedback types, an auction 56 may utilize a differential market feedback format uniquely suited to the requirements of each auction 56, wherein the differential market feedback technology dynamically adjusts the feedback visible to each bidder 30 depending on their position in the auction 56 and other factors.

Abeshouse [0083].

Chambers

9. Chambers describes a system for an auction for bidding by insurance carriers on a request for proposals (RFP) for insurance coverage. Chambers [0033].

10. Chambers describes an insurance broker or client creating the RFP with an insurance engine. Chambers [0038] and [0046].
11. Chambers describes that the clients and brokers have access to the insurance engine using a web page or similar interface. Chambers [0050].
12. Chambers describes that the RFP can be created using product templates, which list possible options that a broker “may then simply selection an existing option.” Chambers [0060] and [0063].
13. Chambers describes that, in the RFP process, the broker completes and selects desired insurance products via an interface provided by the insurance engine. Chambers [0074].
14. Chambers describes that, in the RFP auction process, the broker can “select” carriers to participate from a list. Chambers [0078].
15. Chambers also describes that, in the RFP auction process, the broker can specify rules for the bidding and award process, including rules regarding the scope of information disclosure during the bidding process. Chambers [0079]-[0080].
16. Chambers describes that after the RFP is completed, “[t]he date and time of the RFP distribution can be immediate or at a later time specified by the broker.” Chambers [0081].
17. Chambers states “[w]hile bids can preferably be received any time after the deliver of the RFP, it is anticipated that the majority of bids will start being received after the reply date has passed.” Chambers [0086].

Any differences between the claimed subject matter and the prior art

18. Abeshouse is silent as to how or when the feedback rules were selected and is silent as to whether the computer program has instructions that when executed allows for someone or something to pick a feedback rule from among many feedback rules.
19. Abeshouse does not describe an interface where feedback rules can be selected by an end-user.
20. Chambers is silent as to allowing the end user to change selection of feedback rules for the online auction during the online auction.

The level of skill in the art

21. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of online auctions. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (Quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

22. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and

should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that

the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 11, 14, 16, and 23-36 under §102(b) as anticipated by Abeshouse.

Claims 11, 14, and 16

The Appellants argue that Abeshouse does not describe “computer-executable instructions that when executed implement a method allowing selection of a feedback rule for an online auction contemporaneously with an end-user initiating the online auction.” App. Br. 8-11 and Reply Br. 2-4. The Appellants seem to argue that this requires the instructions to provide “functionality for allowing any person or entity to select a feedback rule for

an online auction contemporaneously with the end-user initiating the online auction.” Reply Br. 2. *See also* App. Br. 9-10. The Appellants argue that there is “no indication in Abeshouse as to how feedback policies are actually put into effect” (App. Br. 11) and assert that “it appears in Abeshouse that the kinds of feedback that are provided during the auction are hard-coded or hard-wired into the system” (App. Br. 10).

The Examiner responds that claim 11 does not require that the end-user selects the rule and that “the rule can be selected in any way by any entity, including automatically based on predetermined conditions” and continues to assert that paragraphs [0089], [0173], and [0174] along with the portions cited in the rejection describe this limitation. Answer 6-7. Further, the Examiner disagrees with Appellants’ assertion that Abeshouse feedback policies are hard-coded or hard-wired into the system and argues that, even if the policies are hard-coded, this still meet the claims. Answer 7.

Anticipation is determined by first construing the claims and then comparing the properly construed claims to the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1346 (Fed. Cir. 2002).

Claim 11 recite computer readable medium contain executable instructions. When executed, the instructions implement a method that *comprises* a step of allowing selection of a feedback rule for an online auction contemporaneously with an end-user initiating the online auction. We note that the Specification does not contain an express definition of “selection.” FF 1. Giving “selection” the broadest reasonable meaning in light of the Specification, we find that “selection” means the act of picking from among many. FF 2-3. Therefore, we construe the claims to require a computer readable medium that contain an instruction that when executed

allows for someone or something to pick a feedback rule from among many feedback rules. The “allowing to pick” happening contemporaneously with an end-user initiating the online auction. The instructions have a structure so that the step of “allowing selection” occurs when the instructions are executed and not a structure that implements a selection that is already made, as the Examiner seems to argue that the claims require (*See Answer 6-7.*)

“Anticipation requires disclosure of each and every claim limitation in a single prior art reference, either explicitly or inherently.” *In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1371 (Fed. Cir. 2007).

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69 (Fed.Cir. 1991).

We find that Abeshouse does describe a system having a computer that is executing instructions that implement an online auction that includes feedback rules. FF 4 and 7. Abeshouse does describe that the feedback rules are selected for each auction. FF 8. However, Abeshouse is silent as to how or when the feedback rules were selected and is silent as to whether the computer program has instructions that when executed allows for someone or something to pick a feedback rule from among many feedback rules. FF 18. We find that it is not inherent that the Abeshouse computer program has instruction that when executed allows for someone or something to pick a feedback rule from among many feedback rules. As the

Appellants argue, it is possible that the selection could have been previously made and hard-coded into the program. App. Br. 11.

Therefore, we find that the Appellants have overcome the prima facie showing of anticipation, and we reverse the rejection of claim 11 and claims 14 and 16, dependent thereon, under 35 U.S.C. §102(b) as anticipated by Abeshouse.

Claims 23 and 24

The Appellants argue claims 23 and 24 as a group. App. Br. 12-16. We select claim 23 as the representative claim for this group, and the remaining claim 24 stands or falls with claim 23. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Claim 23 recites,

a means for executing programs and instructions operable to execute instructions of an auction program . . . where the auction program is operable to provides data to the client computer system over the means for communicating operable to generate an auction interface, and wherein the auction interface permits an end-user of an online auction to select a feedback from a pre-defined list of feedback rules for the online auction.

The Appellants argue that Abeshouse does not describe an auction program providing data to a client computer system for generating an auction interface. App. Br. 12-16 and Reply Br. 4-7. However, we note that the claim is drawn to a system that has a means for executing programs and instruction operable to execute instructions of an auction program, where the auction program is further defined in the claim. This limitation is in means-plus-function format. The function is executing programs and executing

instructions. The program and instructions are capable of operating to execute the instructions of the claimed auction program. This limitation is drawn to the structure of means of executing programs and instructions.

A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999). When the presumption has not been rebutted, means-plus-function claim language must be construed in accordance with 35 U.S.C. §112, paragraph 6, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994).

The Appellants state that this limitation corresponds to the CPU 104 in the Specification, but notably does not state that Auction Program 111 stored in memory 106 corresponds to this limitation. App. Br. 4-5. In the rejection, the Examiner finds that Abeshouse has a processor. Answer 5. *See also* FF 4. The Appellants do not argue that the processor of Abeshouse is not an equivalent to CPU 104 of the Specification. App. Br. 12-16 and Reply Br. 4-7. Accordingly, we find that the Appellants have not overcome the *prima facie* showing of anticipation, and we sustain the rejection of claims 23, and claim 24, dependent thereon, under 35 U.S.C. 102(b) as anticipated by Abeshouse.

Claims 25-36

The Appellants argue that Abeshouse does not describe an “interface means for providing a user interface through which an end-user may input details for an auction, including feedback rules regarding information provided to bidders about status of the auction.” *See* Claim 25.

A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999). When the presumption has not been rebutted, means-plus-function claim language must be construed in accordance with 35 U.S.C. §112, paragraph 6, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994).

The Appellants state that this limitation corresponds to the end-user interface instructions 112 that perform the claimed function. App. Br. 5. For the same reasons as discussed above with regards to claim 11, we find that Abeshouse does not expressly or inherently describe the end-user interface instructions 112 or an equivalent.

Accordingly, we find that the Appellants have overcome the prima facie showing of obviousness, and we reverse the rejection of claim 25, and claims 26-35, dependent thereon, under 35 U.S.C. §102(b) as being anticipated by Abeshouse.

The rejection of claims 12-13 and 17-21 under §103(a) as being unpatentable over Abeshouse and Chambers.

Claim 12

In the arguments, the Appellants grouped claim 12 together with independent claim 11 and address whether Abeshouse anticipates a limitation of claim 11. App. Br. 8-12 and Reply Br. 2-4. However, claim 11 was rejected under §102(b) as being anticipated by Abeshouse, while claim 12 was rejected under §103(a) as unpatentable over Abeshouse and Chambers. The Appellants do not address whether claim 12 is not obvious over the combination of Abeshouse and Chambers. Accordingly, we find that the Appellants have not overcome the prima facie showing of obviousness, and we sustain the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Abeshouse and Chambers. We note that we have entered a new grounds of rejection on claim 11 under §103(a) as being unpatentable over Abeshouse and Chambers below.

Claim 13

Claim 13 depends from claim 11 and recites “the method further comprising allowing the end user to change selection of feedback rules for the online auction during the online auction.” The Appellants argue Abeshouse does not teach allowing the end-user to change selection of feedback rules for the online auction during the online auction. App. Br. 26-27. The Appellants further assert that the Examiner has not cited to any portion of Chambers to teach this limitation. Reply Br. 15.

The Examiner responds that claim 13 was rejected under §103(a) based on a combination of Abeshouse and Chambers and that the Appellants

only address Abeshouse. Answer 14. The Examiner admits that the limitation is not present in Abeshouse. Answer 14. However, the Examiner does not, in their response or rejection, point to the particular portion of Chambers that teach these limitations. Answer 5 and 14. Chambers describes selecting auction rules prior to the auction. FF 11-16.

We find that neither Abeshouse nor Chambers teaches allowing the end user to change selection of feedback rules for the online auction during the online auction. FF 20. Further, the Examiner does not provide any other explanation as to why one of ordinary skill in the art would have found the limitation obvious. Accordingly, we find that the Appellants have overcome the prima facie showing of obviousness and, we reverse the rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Abeshouse and Chambers.

Claim 17-21

The Appellants argue claims 17-21 as a group. App. Br. 24-26. We select claim 17 as the representative claim for this group, and the remaining claims 18-21 stand or fall with claim 17. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The Appellants argue that the combination of Abeshouse and Chambers discloses or suggest “an auction interface permitting an end-user of an online auction to customize feedback of the online auction by selecting a feedback rule from the group consisting of feedback timing, personalized feedback, and feedback based on rank.” App. Br. 24-25 and Reply Br. 12-14. The Appellants argue that, while Abeshouse does show various interfaces, none of the interfaces includes permitting an end-user to select a

feedback rule (App. Br. 25) and that, while Chambers allows user to modify certain information, Chambers “does not say anything at all about an auction interface permitting an end-user of an online auction to customize feedback of the online auction by selecting from a group.” App. Br. 26. Therefore, the Appellants argue that no permissible combination of Abeshouse and Chambers would have rendered claim 17 obvious. App. Br. 26.

The Examiner responds that it is the combination of Abeshouse and Chambers that teaches this limitation. Answer 13-14. We note that in the rejection, the Examiner combined Abeshouse and Chambers to teach this limitation. Answer 5.

We find that the combination of Abeshouse and Chambers teaches this limitation. The Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415. (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at 415.

Abeshouse describes a system having a computer that is executing instructions that implement an online auction that includes feedback rules and Abeshouse describes that the feedback rules are selected for each auction. FF 7-8. Further, Abeshouse describes users using interfaces. FF 5. However, Abeshouse is silent as to whether the auction program provides an interface that allows for an end-user to make the selection of the feedback

rule from a group of feedback rules. However, Chambers also describes a computer executing instructions that implement a similar online auction. FF 9-17. Chambers describes using interfaces that present a creator of the auction with a selection of choice. FF 11.

Given these teachings, one of ordinary skill in the art would permit an end-user to select a feedback rule from among the feedback rules in Abeshouse by providing a selection of choices on an interface. The result is a processor that is operable to execute instruction that provide the interface with the selection. This is no more than the predictable use of prior art elements according to their established functions

Accordingly, we find that the Appellants have not overcome the prima facie showing of obviousness, and we sustain the rejection of claims 17-21 under 35 U.S.C. §103(a) as being unpatentable over Abeshouse and Chambers.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b), we enter a new grounds of rejection on claim 11 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Abeshouse and Chambers and on claims 11-14 and 16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 11 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Abeshouse and Chambers.

We take claim 25 as representative. As discussed above with regard to the rejection of claim 25 under §102(b), we find that Abeshouse does not inherently describe an interface means for providing a user interface through which an end-user may input details for an auction, including feedback rules

regarding information provided to bidders about status of the auction. However, for the same reasons as discussed with regard to the rejection of claim 17 above, we find that this limitation is obvious. Accordingly, we reject claims 11, 23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Abeshouse and Chambers.

Claims 11-14 and 16 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 11 as representative, claim 11 recites “a computer readable medium containing executable instructions.” We note that the Specification is silent as the meaning of “computer readable medium.” Giving claim 11 the broadest reasonable construction, we find that claim 11 encompasses forms of the executable instructions being embodied on a transitory propagating signal *per se*.² A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. §101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

Accordingly, we reject claims 11-14 and 16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have not overcome the prima facie showing of anticipation as to the rejection of claims 23 and 24 or the prima facie showing of obviousness as to the rejection of claims 12 and 17-21.

² See U.S. Patent & Trademark Office, Subject Matter Eligibility of Computer Readable Media, Jan. 26, 2010, available at http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

We conclude that the Appellants have overcome the prima facie showing of anticipation as to the rejection of claims 11, 13, 14, 16, and 25-36.

We enter a new ground of rejection under 35 U.S.C. § 103(a) on claims 11 and 25.

We enter a new ground of rejection under 35 U.S.C. §101 on claims 11-14 and 16.

DECISION

The decision of the Examiner to reject claims 12, 23, 24, and 17-21 is affirmed and to reject claims 11, 13, and 25-36 is reversed.

We enter a new ground of rejection under 35 U.S.C. § 103(a) on claims 11 and 25.

We enter a new ground of rejection under 35 U.S.C. §101 on claims 11-14 and 16.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected,

Appeal 2009-005883
Application 10/683,985

or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

mev

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